

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

CATT ET AL

Serial No.: Continuation of 08/801,212

Group Art Unit: 1743

Filed: Herewith

Examiner: J. Snay

Title: MONITORING METHODS

March 8, 2002

PRELIMINARY SUBMISSION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This is a continuation of the applicants' allowed application Serial No.
08/801,212.

Attached is a copy of PTO-1449 as filed in the applicants' parent case. The
Examiner did not consider the listed references in the parent case for allegedly failing to
comply with the requirements of 37 CFR 1.98(a)(2), the Examiner stating (see Paper No.
25, page 2, 1st ¶):

"The information disclosure statement filed 08/02/00 fails to comply with
37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign
patent; each publication or that portion which caused it to be listed; and all
other information or that portion which caused it to be listed. It has been
placed in the application file, but the information referred to therein has
not be considered. Applicant's statement that the cited references were
previously submitted in another application, Serial No. 08/772,522, is
acknowledged. The earlier filing of references, however, does not satisfy

the requirement of a legible copy of each cited reference because the noted earlier application does not form the basis for a claim of priority in this application. See 37 CFR 1.98(d).”

It is respectfully submitted that the Examiner should have considered the listed references in the parent case and should do so in the present case. The PTO-1449 in the parent case was submitted in timely fashion with the applicants’ Information Disclosure Statement of August 2, 2000 which explained that since there were a large number of references listed and the listed documents related to a number of cases filed by the applicants and/or their assignee, a complete set of the listed documents was being held by Examiner Pamela Wingood. The documents were initially filed in the commonly assigned Serial No. 08/772,522 on June 27, 2000. It is believed to be common practice to rely on such a common deposit of documents when a relatively large number of references is involved and they concern a number of related applications. It is believed that this sort of common deposit is most convenient for all involved and the Examiner, in the circumstances, is requested to consider these references herein.

In the event the Examiner still feels that a new and separate set of the references should be submitted for his consideration in this case, he is requested to advise the applicants in timely fashion so that another set can be prepared for submission. In the parent case, the Examiner did not advise the applicants of his objection until the application was allowed, i.e. more than a year after the applicants’ submission.

A separate PTO-1449 listing the art cited by the Examiner in the parent case is also attached.

It may be that the applicants will be filing a preliminary amendment in this case. Accordingly, if the Examiner should reach the application for action before such amendment is filed, it is requested that the Examiner contact counsel of record.

Respectfully submitted,

MORGAN LEWIS & BOCKIUS LLP



By _____
Paul N. Kokulis
Reg. No. 16773

PNK:mh
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Phone: (202) 739-3000
Facsimile: (202) 739-3001
Direct: (202) 739-5455